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Paper No. 7

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OFFICE OF PETITIONS

In re Application of :
Feng Xu : DECISION GRANTING-IN-PART
Application No. 09/885,379 : PETITION
Filed: 19 June, 2001 :
Attorney's Docket No. 10046.200-US :

This is a decision on the petition filed on 20 August, 2002, which is treated as a petition to withdraw the "Notice of Incomplete Nonprovisional Application" mailed on 19 June, 2002, and to accord the above-identified application a filing date of 19 June, 2001.

On 19 June, 2001, the application was filed, without drawings. Accordingly, on 19 June, 2002, Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application" stating that, *inter alia*, the application had not been accorded a filing date because the application had been deposited without drawings. A two (2)-month period for reply was set.

In response, on 20 August, 2002, the present petition was filed, accompanied by two (2) sheets of drawings. Petitioners concede that no drawings were present among the application papers filed on 19 June, 2001, but state that the drawings do not include any new matter because this application incorporates by reference the entire disclosure of prior application No. 09/596,795.

Since no two (2) sheets of drawings were a part of the papers filed on 19 June, 2001, the application cannot be accorded a filing date with these sheets of drawings as a part of the original disclosure of this application.

However, a review of the record reveals that Claims 1-5, 7-10,

13, and 15-17 as originally filed and Claims 6, 12, 18, 22, 25, 28, and 32 as amended, are method claims. It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).¹ Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date without the drawings.

In view of the above, the "Notice" mailed 19 June, 2002, was mailed in error and is hereby withdrawn.

The petition is granted to the extent that the application will be accorded a filing date of 19 June, 2001, without drawings as a part of the original disclosure of this application

The two (2) sheets of drawings filed with the present petition will not be used for processing or examination, but will be retained in the application file.

Section 201.06(c) of the Manual of Patent Examining Procedure states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.
(emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawings filed with the present petition are not new matter if they were a part of the disclosure of the prior application. If petitioners wish to have the drawings entered in the application, a preliminary amendment adding the drawings should be filed prior to the first Office action.

¹MPEP 601.01(f).

The fee of \$130.00 paid with the present petition will be refunded to counsel's deposit account, No. 50-1701.

Receipt of the declaration filed 20 August, 2002, is acknowledged.

The application is being returned to the Office of Initial Patent Examination for reprocessing with a filing date of 19 June, 2001, using the application papers filed on that date, and an indication in USPTO records that zero (0) sheets of drawings were present on filing.

Telephone inquiries specific to this matter should be directed to the undersigned at 703 308-6918.



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